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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 18

Application Number: 09/045,036
Filing Date: March 20, 1998
Appellant(s): Jay S. Walker

Dean Alderucci, Reg. No. 40,484
For Appellant

EXAMINER'S ANSWER

This is in response to Appellant's brief on appeal filed June 30, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief contains a statement identifying a related pending appeal for Serial No. 09/107,971 which will directly affect or be directly affected by or have a bearing on the decision in the instant appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The Appellant's statement of the issues contained in the brief is correct.

(7) Grouping of Claims

AGREEMENT WITH APPELLANT'S STATEMENT OF GROUPING OF CLAIMS

The Appellant's statement in the brief that certain claims stand or fall together finds support provided in arguments of the brief as to why certain claims stand or fall together pursuant to 37 CRF 1.192(c) (7) and (c) (8).

(8) Claims Appealed

COPY OF APPEALED CLAIMS IN APPENDIX IS CORRECT

A correct copy of appealed claims appears in Appellant's brief.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejections of claims under appeal.

Number	Name	Date	
US 5,548,110	Storch	August 20, 1996	
US 5,772,510	Roberts	June 30, 1998	
	The Economist	June 13, 1992	vol. 323, p. 74

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-36 stand rejected under 35 U.S.C. 103(a).

These rejections are set forth in the prior Office Actions as follows:

CLAIM REJECTIONS— 35 U.S.C. §103(a)

4. **Rejections Maintained.**

ORIGINAL 35 U.S.C. §103(a) REJECTIONS

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Independent claims 1, 6, 11-13 & 17 and dependent claims 2-5, 7-10, 14-16, 18-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Storch 5,548,110 (8/20/1996) (herein referred to as "Storch") in view of Roberts 5,772,510 (6/30/1998) [US f/d: 10/26/1995] (herein referred to as "Roberts") and further in view of "Heads I win, tails you lose." The Economist (13 June 1992) v. 323, p. 74 (herein referred to as "The Economist").

As per claim 1, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest:

A method for facilitating the purchase of fractional lottery tickets using a point-of-sale terminal, comprising: determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and storing the ticket identifier and the portion identifier.

Storch lacks an explicit recitation of: "outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2B, el. 20b; and col. 4, ll. 5-65) shows elements that suggest "outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket. . . ."

Roberts proposes ticket identifier modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "[sending]

. . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

Storch lacks an explicit recitation of: "determining a monetary value. . . ."

The Economist (p. 1) shows elements that suggest "determining a monetary value. . . ."

The Economist proposes monetary determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

As per claim 2, Storch in view of Roberts and further in view of The Economist shows the method of claim 1. (See the rejection of claim 1 supra).

Storch lacks an explicit recitation of: "determining a monetary value based on an amount of change due for a purchase. . . ."

The Economist (p. 1) shows elements that suggest "determining a monetary value based on an amount of change due for a purchase. . . ."

The Economist proposes monetary determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The

Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

As per claim 3, Storch in view of Roberts and further in view of The Economist shows the method of claim 1. (See the rejection of claim 1 supra).

Storch lacks an explicit recitation of: "selecting the ticket from a plurality of tickets. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 6A & FIG. 6B) shows elements that suggest "selecting the ticket from a plurality of tickets. . . ."

Roberts proposes ticket selection modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means "for dispensing completed lottery tickets from a vending machine." (See Roberts (col. 2, ll. 59-60)).

As per claim 4, Storch in view of Roberts and further in view of The Economist shows the method of claim 3. (See the rejection of claim 3 supra).

Storch lacks an explicit recitation of: "selecting the ticket having an unallocated portion at least as great as the monetary value. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2A; FIG. 5; & FIG. 8A) shows elements that suggest "selecting the ticket having an unallocated portion at least as great as the monetary value. . . ."

Roberts proposes ticket selection modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means "for dispensing completed lottery tickets from a vending machine." (See Roberts (col. 2, ll. 59-60)).

As per claim 5, Storch in view of Roberts and further in view of The Economist shows the method of claim 3. (See the rejection of claim 3 supra).

Storch lacks an explicit recitation of: "determining a set of tickets that each have an unallocated portion at least as great as the monetary value; and selecting a ticket from the set of tickets which has a minimal unallocated portion. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG.

50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2A; FIG. 5; & FIG. 8A) shows elements that suggest "determining a set of tickets that each have an unallocated portion at least as great as the monetary value; and selecting a ticket from the set of tickets which has a minimal unallocated portion. . . ."

Roberts proposes ticket selection modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means "for dispensing completed lottery tickets from a vending machine." (See Roberts (col. 2, ll. 59-60)).

Claims 6, 11 & 12 are rejected for substantially the same reasons as claim 1.

Claim 7 is rejected for substantially the same reasons as claim 2.

Claim 8 is rejected for substantially the same reasons as claim 3.

Claim 9 is rejected for substantially the same reasons as claim 4.

Claim 10 is rejected for substantially the same reasons as claim 5.

As per claim 13, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest: A method for facilitating the purchase of fractional lottery tickets using a point-of-sale terminal, comprising: determining a monetary value . . . allocating at least a portion of the selected ticket, the portion being based on the monetary value. . . ."

Storch lacks an explicit recitation of: "determining an amount of change due for a purchase; determining a monetary value based on the amount of change due; selecting a ticket from a plurality of tickets, the selected ticket having an unallocated portion at least as great as the monetary value; allocating at least a portion of the selected ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the selected ticket; and storing the ticket identifier and the portion identifier."

The Economist (p. 1) shows elements that suggest "determining an amount of change due for a purchase; determining a monetary value based on the amount of change due. . . ."

The Economist proposes monetary determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The

Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

Roberts (FIG. 6A & FIG. 6B) shows elements that suggest "selecting a ticket from a plurality of tickets. . . ."

Roberts (FIG. 2A; FIG. 5; & FIG. 8A) shows elements that suggest "the selected ticket having an unallocated portion at least as great as the monetary value. . . ."

Roberts proposes ticket selection modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means "for dispensing completed lottery tickets from a vending machine." (See Roberts (col. 2, ll. 59-60)).

Roberts (FIG. 2B, el. 20b; and col. 4, ll. 5-65) shows elements that suggest "outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the selected ticket . . . and storing the ticket identifier and the portion identifier. . . ."

Roberts proposes ticket identifier modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "[sending] . .

. ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

As per claim 14, Storch in view of Roberts and further in view of The Economist shows the method of claim 13. (See the rejection of claim 13 supra).

Storch lacks an explicit recital of "rounding the amount of change due to a predetermined multiple, thereby generating a rounded change amount; and setting the monetary value equal to the rounded change amount."

The Economist (p. 1) shows elements that suggest "rounding the amount of change due to a predetermined multiple, thereby generating a rounded change amount; and setting the monetary value equal to the rounded change amount."

The Economist proposes change rounding determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

As per claim 15, Storch in view of Roberts and further in view of The Economist shows the method of claim 14. (See the rejection of claim 14 supra).

Storch lacks an explicit recital of "rounding down the amount of change due to a predetermined multiple, thereby generating a rounded-down change amount."

The Economist (p. 1) shows elements that suggest "rounding down the amount of change due to a predetermined multiple, thereby generating a rounded-down change amount."

The Economist proposes change rounding determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

As per claim 16, Storch in view of Roberts and further in view of The Economist shows the method of claim 13. (See the rejection of claim 13 supra).

Storch lacks an explicit recital of "outputting an offer to exchange a fractional lottery ticket for change due."

The Economist (p. 1) shows elements that suggest "outputting an offer to exchange a fractional lottery ticket for change due."

The Economist proposes outputting offer modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the

system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

Claim 17 is rejected for substantially the same reasons as claim 13.

Claim 18 is rejected for substantially the same reasons as claim 14.

Claim 19 is rejected for substantially the same reasons as claim 15.

Claim 20 is rejected for substantially the same reasons as claim 16.

REVISED 35 U.S.C. §103(a) REJECTIONS

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 21-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Storch in view of Roberts and further in view of The Economist.

As per claim 21, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13,

ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 22.

Storch lacks an explicit recitation of "determining a portion of the prize value based on the allocated portion of the ticket. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2B, el. 20b; and col. 4, ll. 5-65) shows elements that suggest "determining a portion of the prize value based on the allocated portion of the ticket."

Roberts proposes ticket prize determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

Storch lacks an explicit recitation of: "determining the prize value. . . ."

The Economist (p. 1) shows elements that suggest ""determining the prize value. . . ."

The Economist proposes monetary determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

Claim 22 is rejected for substantially the same reasons as claim 21.

As per claim 23, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 23.

Storch lacks an explicit recitation of "providing a portion of the prize value based on the allocated portion of the ticket. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2B, el. 20b; and col. 4, ll. 5-65) shows elements that suggest "providing a portion of the prize value based on the allocated portion of the ticket. . . ."

Roberts proposes ticket prize determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

Storch lacks an explicit recitation of: "determining the prize value of the ticket. . . ."

The Economist (p. 1) shows elements that suggest "determining the prize value of the ticket. . . ."

The Economist proposes monetary determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining the prize value. . . ." (See The Economist (p. 1)).

Claim 24 is rejected for the same reasons as claim 23.

7. Claims 21-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Storch in view of Roberts.

As per claim 25, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 25.

Storch lacks an explicit recitation of "maintaining a supply of tickets, each ticket having an unallocated portion thereof; acquiring an additional ticket. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "maintaining a supply of tickets, each ticket having an unallocated portion thereof; acquiring an additional ticket. . . ."

Roberts proposes ticket storage modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means

for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

As per claim 26, Storch in view of Roberts shows the rejection of claim 25.

Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 26.

Storch lacks an explicit recitation of "counting a number of tickets having an unallocated portion that is above a first predetermined threshold; and acquiring an additional ticket if the number if tickets having an unallocated portion that is above the first predetermined threshold is below a second predetermined threshold."

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "counting a number of tickets having an unallocated portion that is above a first predetermined threshold; and acquiring an additional ticket if the number if tickets having an unallocated portion that is above the first predetermined threshold is below a second predetermined threshold."

Roberts proposes ticket threshold modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

As per claim 27, Storch in view of Roberts shows the rejection of claim 25.

Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 27.

Storch lacks an explicit recitation of suggest the elements and limitations of claim 27.

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "receiving an indication of a requested portion; counting a number of tickets having an unallocated portion that is above the requested portion; and acquiring an additional ticket if the number of tickets having unallocated portion that is above the requested portion is below a predetermined threshold."

Roberts proposes ticket counting modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

As per claim 28, Storch in view of Roberts shows the rejection of claim 25.

Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 28.

Storch lacks an explicit recitation of suggest the elements and limitations of claim 28.

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "acquiring a predetermined number of additional tickets."

Roberts proposes ticket acquiring modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with

the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

As per claim 29, Storch in view of Roberts shows the rejection of claim 25.

Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 29.

Storch lacks an explicit recitation of suggest the elements and limitations of claim 29.

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "calculating a sum of the unallocated portions of the tickets."

Roberts proposes ticket calculating modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See

Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

As per claim 30, Storch in view of Roberts shows the rejection of claim 29.

Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 30.

Storch lacks an explicit recitation of suggest the elements and limitations of claim 30.

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "acquiring an additional ticket if the calculated sum is below a predetermined threshold."

Roberts proposes ticket acquiring modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

Claim 31 is rejected for substantially the same reasons as claim 25.

Claim 32 is rejected for substantially the same reasons as claim 26.

Claim 33 is rejected for substantially the same reasons as claim 27.

Claim 34 is rejected for substantially the same reasons as claim 28.

Claim 35 is rejected for substantially the same reasons as claim 29.

Claim 36 is rejected for substantially the same reasons as claim 30.

(11) Response to Arguments

Appellant's arguments (Appeal Brief, paper#17; filed 06/30/2003) concerning the claim rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

In response to Appellant's argument (Appeal Brief; paper#17; pp. 10-13; and p. 14, ll. 1-7; p. 27; p. 28; p. 29, ll. 1-8; p. 32; p. 33, ll. 1-13; p. 36; p. 37, ll. 15; p. 40; p. 41, ll. 16-20; p. 44; p. 45; p. 46; p. 47, ll. 1-14; p. 48, ll. 1-8; p. 49, ll. 23-26; p. 51; p. 52; p. 56; p. 57; p. 62; p. 63; p. 66; p. 67; p. 71; and p. 72) which alleges that "the Examiner

has failed to set forth the required prima facie case of unpatentability of any claim. . . ." amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to Appellant's argument (Appeal Brief; paper#17; pp. 10-13; and p. 14, ll. 1-7; p. 27; p. 28; p. 29, ll. 1-8; p. 32; p. 33, ll. 1-13; p. 36; p. 37, ll. 15; p. 40; p. 41, ll. 16-20; p. 44; p. 45; p. 46; p. 47, ll. 1-14; p. 48, ll. 1-8; p. 49, ll. 23-26; p. 51; p. 52; p. 56; p. 57; p. 62; p. 63; p. 66; p. 67; p. 71; and p. 72) which alleges that "the Examiner has not presented a prima facie case of obviousness of any claim of . . .", this is not the case.

It is well settled that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the teachings of the references would have suggested in the broadest interpretation to those of ordinary skill in the art. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

It is also well settled in the law that

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(a) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. . . . (See MPEP 706.02(j)).

In this case, the Prior Office Action relies upon the combined teachings, suggestions and motivations found in the references as well as the knowledge generally available to one of ordinary skill in the art and does not include knowledge gleaned from the Applicant's disclosure. Furthermore, the Prior Office Action indicates the requisite "reasonable expectation of success" is established by virtue of combining the teachings of allowed patents cited as prior art references in the rejections. Furthermore, the combination of the teachings in the prior art references suggests all the claim limitations. Finally, the teachings and suggestions to make the claimed combinations and the reasonable expectation of success are both found in the prior art and not based on Applicant's disclosure; furthermore, in response to Applicant's argument that the

references fail to show certain features of Applicant's invention, it is noted that the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, based on the above response, *prima facie* obviousness is established in the prior Office Action for all of the claims of the instant invention to include Group I of the instant appeal.

In response to Appellant's argument (Appeal Brief; paper#17; pp. 14-15; p. 28, ll. 5-27; p. 32, ll. 22-26; p. 33, ll. 1-8; p. 36, ll. 23-25; p. 37, ll. 1-10; p. 41, ll. 15; p. 47, ll. 15-29; p. 52, ll. 8-20; p. 57, ll. 5-17; p. 63, ll. 1-10; p. 67, ll. 3-17; and p. 72, ll. 7-17) which alleges that the claims are patentable because of certain advantages, it is noted that the features upon which Applicant relies (e.g., "a 26% share of a $1 lottery ticket. . . ." etc.) are not recited in rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Appellant's argument (Appeal Brief; paper#17; pp. 17-19; and p. 20, ll. 1-12; and p. 25, ll. 1-18) which alleges that "the cited portions . . . [of the Storch reference] do not at all suggest the claimed limitations. . . . [of allocating a portion of a ticket]", this is not the case.

In this case, as per claim 1, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest:

> A method for facilitating the purchase of fractional lottery tickets using a point-of-sale terminal, comprising: determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and storing the ticket identifier and the portion identifier.

For example, Storch (col. 132, ll. 33-50) discloses: *"Bar Coded Currency Serial Numbers. . . . a specific format of BCB coding for Random ID numbers is described using currency as an example . . . and other objects may be similarly barcoded."*

Storch (FIG. 22; FIG. 28; FIG. 24; FIG. 1; FIG. 2; FIG. 25; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; and col. 70, ll. 50-64) shows coding of lottery tickets.

The Examiner interprets the above disclosures as suggesting the preamble elements (i.e., A method for facilitating the purchase of fractional lottery tickets using a point-of-

sale terminal. . . .) and showing "determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and storing the ticket identifier and the portion identifier."

Furthermore, Taken in the context of the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 and the 35 USC §103(a) obviousness rejection requirements, the prior Office Action recitations of "Storch lacks an explicit recitation. . . ." of the features at issue does not constitute a concession in the rejection by the Office of any deficiency in the relied upon reference; to the contrary such recitations merely provide the transition phraseology to the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 and to the 35 USC §103(a) Obviousness proposition that even though the Storch reference does not explicitly recite the claimed elements and limitations, the reference does in fact suggest the claimed elements and limitations of the instant invention; and therefore, the elements and limitations of the instant invention are rendered obvious. For example, see the rejection of claim 1 supra and Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50).

In response to Appellant's argument (Appeal Brief; paper#17; p. 20, ll. 13-25; p. 21, ll. 1-19; and p. 25, ll. 19-26) which alleges "No showing that the references suggest outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket. . . .", this is not the case.

In this case, as per claim 1, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest:

> fractional lottery tickets . . . determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and storing the ticket identifier and the portion identifier.

For example, Storch (col. 132, ll. 33-50) discloses: *"Bar Coded Currency Serial Numbers. . . . a specific format of BCB coding for Random ID numbers is described using currency as an example . . . and other objects may be similarly barcoded."*

Storch (FIG. 22; FIG. 28; FIG. 24; FIG. 1; FIG. 2; FIG. 25; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; and col. 70, ll. 50-64) shows coding of lottery tickets with identifiers.

The Examiner interprets the above disclosure as showing "determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and storing the ticket identifier and the portion identifier."

In response to Appellant's argument (Appeal Brief; paper#17; p. 21, ll. 20-29; and p. 22, ll. 1-3; and p. 26) which alleges "No showing that the references suggest storing the ticket identifier and the portion identifier. . . .", this is not the case.

In this case, as per claim 1, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest:

> fractional lottery tickets . . . determining a monetary value; allocating a portion of a ticket, the portion being based on the monetary value; outputting a ticket identifier that identifies the ticket and a portion identifier that identifies the allocated portion of the ticket; and storing the ticket identifier and the portion identifier.

For example, Storch (col. 132, ll. 33-50) discloses: *"Bar Coded Currency Serial Numbers. . . . a specific format of BCB coding for Random ID numbers is described using currency as an example . . . and other objects may be similarly barcoded."*

Storch (FIG. 22; FIG. 28; FIG. 24; FIG. 1; FIG. 2; FIG. 25; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; and col. 70, ll. 50-64) shows coding of lottery tickets with identifiers.

The Examiner interprets the above disclosure as showing "storing the ticket identifier and the portion identifier."

In response to Appellant's argument (Appeal Brief; paper#17; p. 22, ll. 4-25; p. 23; p. 24, ll. 1-9; p. 30, ll. 6-26; p. 34; p. 35, ll. 1-2; p. 38, ll. 2-24; p. 42; p. 43, ll. 1-7; p. 49; p. 53; p. 54, ll. 1-17; p. 58, ll. 24-27; p. 59; p. 60, ll. 1-11; p. 64, ll. 10-14; p. 69; and p. 73) which alleges "No showing of a proper motivation to combine the references. . . .", this is not the case.

It is well settled in the law that "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ." (See MPEP 2144 RATIONALE DIFFERENT FROM APPLICANT'S IS PERMISSIBLE (August 2001) p. 2100-127; and *In re Beattie,* 24 USPQ2d 1040 (CA FC 1992) "Board of Patent Appeals and Interferences correctly held that . . . **[the] . . .** law of **obviousness does not require**

that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole."

It is also well settled in the law, that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, and throughout the prior Office Action the obviousness rejections have relied upon the knowledge generally available to one of ordinary skill in the art and the prior Office Action has detailed with particularity where the features of claims are suggested in the prior art references and where there are teachings in the references to modify and /or combine the references to derive the present invention.

In response to Appellant's argument (Appeal Brief; paper#17; p. 24, ll. 10-23; p. 60; and p. 64) which alleges "Nonalalogous References. . . ." are used in the obviousness rejections of the prior Office Action, this is not the case.

It is well settled in the law that "a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of

the claimed invention." See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, the prior art references relied upon are in the field of Applicant's endeavor and is also reasonably pertinent to the particular problem with which the Applicant was concerned.

In response to Appellant's argument (Appeal Brief; paper#17; p. 29, ll. 9-27; p. 30, ll. 1-5; and p. 31, ll. 4-18) which alleges that "there is no showing that the references suggest *allocating a portion of a ticket . . . based on an amount of change due for a purchase. . . .*", The Economist (p. 1) discloses: *"If the result is less than or equal to the amount of change in the price, the price is rounded. . . . and . . . eliminates the need for change in most transactions."* The Examiner interprets this disclosure as showing that The Economist suggests in view of Storch "*allocating a portion of a ticket . . . based on an amount of change due for a purchase. . . .*" as detailed below:

As per claim 2, Storch in view of Roberts and further in view of The Economist shows the method of claim 1. (See the rejection of claim 1 supra).

Storch lacks an explicit recitation of: "determining a monetary value based on an amount of change due for a purchase. . . ."

The Economist (p. 1) shows elements that suggest "determining a monetary value based on an amount of change due for a purchase. . . ."

The Economist proposes monetary determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 33, ll. 14-26; and p. 35, ll. 7-17) which alleges that "The references do not suggest selecting the ticket from a plurality of tickets. . . .", this is not the case.

As per claim 3, Storch in view of Roberts and further in view of The Economist shows the method of claim 1. (See the rejection of claim 1 supra).

Storch lacks an explicit recitation of: "selecting the ticket from a plurality of tickets. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 6A & FIG. 6B) shows elements that suggest "selecting the ticket from a plurality of tickets. . . ."

Roberts proposes ticket selection modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and

method of Storch because such combination would have provided means "for dispensing completed lottery tickets from a vending machine." (See Roberts (col. 2, ll. 59-60)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 37, ll. 16-27; p. 38, ll. 4-15; p. 43; p. 63 and p. 65) which alleges that "The references do not suggest selecting a ticket having an unallocated portion at least as great as the monetary value. . . .", this is not the case.

Storch lacks an explicit recitation of: "selecting the ticket having an unallocated portion at least as great as the monetary value. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2A; FIG. 5; & FIG. 8A) shows elements that suggest "selecting the ticket having an unallocated portion at least as great as the monetary value. . . ."

Roberts proposes ticket selection modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means "for dispensing completed lottery tickets from a vending machine." (See Roberts (col. 2, ll. 59-60)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 41, ll. 21-25; and p. 42) which alleges "No showing that the references suggest determining a set of tickets that each have an unallocated portion at least as great as the monetary value; and selecting a ticket from the set of tickets which has a minimal unallocated portion. . . .", this is not the case.

As per claim 5, Storch in view of Roberts and further in view of The Economist shows the method of claim 3. (See the rejection of claim 3 supra).

Storch lacks an explicit recitation of: "determining a set of tickets that each have an unallocated portion at least as great as the monetary value; and selecting a ticket from the set of tickets which has a minimal unallocated portion. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2A; FIG. 5; & FIG. 8A) shows elements that suggest "determining a set of tickets that each have an unallocated portion at least as great as the monetary value; and selecting a ticket from the set of tickets which has a minimal unallocated portion. . . ."

Roberts proposes ticket selection modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and

method of Storch because such combination would have provided means "for dispensing completed lottery tickets from a vending machine." (See Roberts (col. 2, ll. 59-60)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 48; and p. 50) which alleges "The references do not suggest rounding the amount of change due to a predetermined multiple, thereby generating a rounded change amount; and setting the monetary value equal to the rounded change amount. . . .", this is not the case.

As per claim 14, Storch in view of Roberts and further in view of The Economist shows the method of claim 13. (See the rejection of claim 13 supra).

Storch lacks an explicit recital of "rounding the amount of change due to a predetermined multiple, thereby generating a rounded change amount; and setting the monetary value equal to the rounded change amount."

The Economist (p. 1) shows elements that suggest "rounding the amount of change due to a predetermined multiple, thereby generating a rounded change amount; and setting the monetary value equal to the rounded change amount."

The Economist proposes change rounding determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 53; and p. 54) which alleges "The references do not suggest outputting an offer to exchange a fractional lottery ticket for change due. . . ." , this is not the case.

As per claim 16, Storch in view of Roberts and further in view of The Economist shows the method of claim 13. (See the rejection of claim 13 supra).

Storch lacks an explicit recital of "outputting an offer to exchange a fractional lottery ticket for change due."

The Economist (p. 1) shows elements that suggest "outputting an offer to exchange a fractional lottery ticket for change due."

The Economist proposes outputting offer modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 58; and p. 61) which alleges "The references do not suggest that a portion of the prize value is based on the allocated portion of the ticket. . . .", this is not the case.

Storch lacks an explicit recitation of "determining a portion of the prize value based on the allocated portion of the ticket. . . ." even though Storch (FIG. 1;

FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 2B, el. 20b; and col. 4, ll. 5-65) shows elements that suggest "determining a portion of the prize value based on the allocated portion of the ticket."

Roberts proposes ticket prize determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

Storch lacks an explicit recitation of: "determining the prize value. . . ."

The Economist (p. 1) shows elements that suggest ""determining the prize value. . . ."

The Economist proposes monetary determination modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of The Economist with the system and method of Storch because such combination

would have provided means for "determining a monetary value. . . ." (See The Economist (p. 1)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 67; p. 68; p. 69; and p. 70) which alleges "No showing that the references suggest counting a number of tickets having an unallocated portion that is above anything. . . ." and "No showing that the references suggest acquiring an additional ticket if any condition is true. . . ." , this is not the case.

As per claim 26, Storch in view of Roberts shows the rejection of claim 25.

Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 26.

Storch lacks an explicit recitation of "counting a number of tickets having an unallocated portion that is above a first predetermined threshold; and acquiring an additional ticket if the number if tickets having an unallocated portion that is above the first predetermined threshold is below a second predetermined threshold."

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "counting a number of tickets having an unallocated portion that is

above a first predetermined threshold; and acquiring an additional ticket if the number if tickets having an unallocated portion that is above the first predetermined threshold is below a second predetermined threshold."

Roberts proposes ticket threshold modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)); furthermore,

As per claim 25, Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 25.

Storch lacks an explicit recitation of "maintaining a supply of tickets, each ticket having an unallocated portion thereof; acquiring an additional ticket. . . ." even though Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) suggests the same.

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "maintaining a supply of tickets, each ticket having an unallocated portion thereof; acquiring an additional ticket. . . ."

Roberts proposes ticket storage modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

In response to Appellant's argument (Appeal Brief; paper#17; p. 72; and p. 74) which alleges "No showing that the references suggest calculating a sum of the unallocated portions of the tickets. . . .", this is not the case.

As per claim 29, Storch in view of Roberts shows the rejection of claim 25.

Storch (FIG. 1; FIG. 2; FIG. 22; FIG. 24; FIG. 25; FIG. 28; FIG. 29; FIG. 31; FIG. 32; FIG. 34; FIG. 50; col. 6, ll. 26-48; col. 8, ll. 17-40; col. 13, ll. 27-30; col. 70, ll. 50-64; and col. 132, ll. 33-50) shows elements that suggest the elements and limitations of claim 29.

Storch lacks an explicit recitation of suggest the elements and limitations of claim 29.

Roberts (FIG. 1; FIG. 2A, FIG. 6; Fig. 5; FIG. 6A; and FIG.) shows elements that suggest "calculating a sum of the unallocated portions of the tickets."

Roberts proposes ticket calculating modifications that would have applied to the system and method of Storch. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Roberts with the system and method of Storch because such combination would have provided means for "dispensing completed lottery tickets from a vending machine." (See Roberts (col. 62 ll. 59-60)) and for "[sending] . . . ticket completion information necessary to provide a completed lottery ticket. . . ." (See Roberts (col. 6, ll. 54-55)).

(12) Examiner's Answer, Conclusion

For all of the reasons stated above, Appellant's brief fails to overcome the obviousness rejections of claims 1-36. And for the above stated reasons, the rejections must be sustained.

Respectfully, presented,

John L. Young
September 8, 2003

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